

## REMARKS

Claims 1-18 are pending in this application. Of these, claims 10-18 stand withdrawn from consideration per applicant's previous election to prosecute claims 1-9. Claims 3, 4 and 7 have been amended with this response.

### Re Application Papers:

It is noted that in the present official action that there has been no objection to the specification, drawings, proposed drawing corrections, the oath or declaration.

### Re: Priority:

It is noted that acknowledgment has been made of applicant's claim for foreign priority under 35 USC 119 and that all certified copies of the priority documents have been received.

### Re IDS:

The specification of this application discusses a prior art reference EPO 706 178. In section (4) of the official action the examiner reminded applicant that 37 CFR 198(b) requires that prior art must be presented in a separate paper for consideration by the examiner. With this response, applicant would like the prior art mentioned in the specification to be considered. Accordingly, a copy of EPO 706 178 is being ordered and will be submitted subsequently in a supplementary IDS along with any translation or corresponding counterpart patent if necessary.

Consideration of applicant's supplementary IDS, when available, is respectfully requested.

Re Amended Claim 7:

5 In the official action, dependent Claim 7 was *objected* to on Form PTO-326 but not otherwise discussed in the official action. It is presumed that this rejection was based on the rejection of its base claim (1). No other grounds of rejection were mentioned.

10 In view of the foregoing, dependent Claim 7 has been placed in independent form including all of the limitations of its base claim (1). As amended to independent form, Claim 7 is therefore now allowable and such action is respectfully requested.

15 Re Claims 3-5:

Dependent claims 3-5 were rejected under 35 USC 112. In applying this rejection the examiner stated that "The terms 'too low' and 'which suffices' are relative and vague terms. It is not readily apparent what structure they encompass."

20 It is respectfully submitted that the expression "too low" is not a relative and vague term in this claim. This is because the claim clearly states that the transmission factor of one group of layers is lower than the lowest transmission factor, which allows to pass through said group  
25 of layers a quantity of light, which is sufficient for writing operation on the other layer. Of course, depending on characteristics of the other layer, this transmission factor may change, but in dependency on said characteristics. It is further noted, that the laser power cannot be increased indefinitely, because (a) laser sources are not able to

generate indefinite power, and (b) layers to be passed do not stand indefinite power.

Notwithstanding the foregoing, and in view of clarifying the  
5 inventive features of Claim 3, this dependent claim has been amended to overcome this ground of rejection by the recitation that the total transmission factor is "...lower than the lowest transmission factor that allows to pass through said information carrier layer with associated covering layer and separating layer a quantity of light being sufficient  
10 for a writing operation on the other information layer."

As amended, dependent Claim 3 is submitted to clearly overcome the rejection under 35 USC 112 and is in allowable condition. Dependent Claim 4 has been similarly and is also allowable.  
15 Dependent Claim 5 is allowable at least for the same reasons as amended dependent Claim 4.

Reconsideration and allowance of dependent claims 3-5 is believed to be in order and is respectfully requested.

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Re Claims 1, 2, 8 and 9:

Claims 1, 2, 8 and 9 were rejected under 35 USC 102 as being anticipated by Nagashima (US 5,876,823). This rejection is respectfully traversed for the following reasons.

25

Nagashima shows in Fig. 1 that both layers 2 and 6 are provided with a reflective layer 3 and 7, respectively. In Figure 5 it is shown that layer 52 is coated with a semi-transparent film 53 but layer 56 is provided with a reflective film 57. Nagashima, therefore, does neither

show nor give a hint to make both layers semi-transparent as recited in Claim 1.

As to Claim 2, Nagashima shows that at least one of the layer is  
5 reflective, which means that both layers "can not" be "read from both  
sides". Even if both layers of the Nagashima disclosure would be  
provided with a recordable film, they, they could not be read from both  
sides. The claimed feature of claim 2 is, therefore neither shown nor  
made obvious by Nagashima. Claims 8 and 9 are allowable at least  
10 for the same reasons as Claim 1.

Re Claim 6.

Claim 6 was rejected under 35 USC 103 as being unpatentable  
over Nagashima. In applying this rejection, it is acknowledged that  
15 Nagashima is silent as to the separating layer having an additional  
information carrier layer. No art is cited for the claimed further layer. It  
is submitted that claim is thus clearly allowable at least for the same  
reasons as its base claim (1).

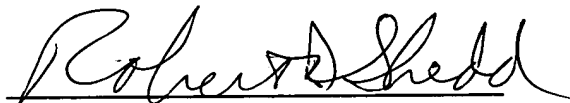
20 Fees:

As originally filed this case contained six (6) independent claims  
and a total of nineteen (19) claims. As amended, Claim 7 has been  
placed in independent form. Please charge the cost of this added  
independent claim to applicant's Deposit Account Number 07-0832.  
25 A separate paper is enclosed (in duplicate) authorizing this charge.

The application, as amended, is believed to be in condition for allowance and such action is respectfully requested.

Please address all communications to:  
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Respectfully submitted,



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Certificate of Mailing Pursuant to 37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in a postage paid envelope addressed to: Assistant Commissioner of Patents, Washington, D.C. on the date indicated below.

1/22/02  
Date Deposited

Robert D. Shedd  
Signature Reg. # 36,269

Enclosures: Copy of amended claims showing changes made.

Petition for extension of time.

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Authorization to charge Deposit Account (in duplicate)

Marked Up Copy of Amended Claims Showing Changes Made

3. (Once Amended) Optical recording medium according to claim 2, wherein the total transmission factor of an information carrier layer with associated covering layer and separating layer is lower than the lowest transmission factor that allows to pass through said information carrier layer with associated covering layer and separating layer [too low to allow] a quantity of light [which suffices] being sufficient for a writing operation [to pass ] on the other information carrier layer.

4. (Once Amended) Optical recording medium according to Claim 1, wherein the total transmission factor of an information carrier layer with associated covering layer and separating layer is lower than the lowest transmission factor that allows to pass through said information carrier layer with associated covering layer and separating layer [too low to allow] a quantity of light [which suffices] being sufficient for a writing operation [to pass to] on the other information carrier layer.

7. (Once Amended) Optical recording medium [according to claim 1] comprising two information carrier layers, on which information can be written by means of a focused light beam, a separating layer arranged between said information carrier layers, and a transparent covering layer, which is arranged between said information carrier layer and a surface of the recording medium and whose thickness substantially exceeds that of said information carrier layer,

wherein: both information carrier layers are semi-transparent and  
wherein the information carrier layers [(2, 3)], given the presence of two information layers [(2, 3)], is less than 10%. ?

a total transmission factor of said two information layers, is less than 10%.